

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SEYMOUR KAPLAN

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Appeal No. 97-0256  
Application 08/233,215<sup>1</sup>

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ON BRIEF

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Before ABRAMS, FRANKFORT and NASE, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3 and 5 through 7, which are the only claims remaining in this application. Claim 4 has been

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<sup>1</sup>Application for patent filed April 25, 1994. According to appellant, this application is a continuation of application 07/900,674, filed June 19, 1992, now abandoned.

canceled. On page 3 of the examiner's answer (Paper No. 20), the examiner has indicated that dependent claim 3 is now objected to and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This determination leaves for our review in this appeal only the examiner's rejections of claims 1, 2 and 5 through 7.

Appellant's invention relates to a reversible writing pad (14) seen in Figures 1-3 of the application drawings, wherein said writing pad has a main substantially rectangular writing surface or message recording area (24) and an extension (18) extending from the main message recording area so as to form a substantially "L" shaped combined writing surface and extension. As shown in Figure 1, the extension (18) is generally provided for placement between a person's elbow and a support surface (20), such as a table or desk top surface, to allow the writing pad to be held in place beneath said elbow while the person is writing on the message recording area (24) with the other hand. A substantially correct copy of claims 1 through 3 and 5 through 7 may be found in the Appendix to appellant's brief. Minor

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errors in this copy of the claims have been noted on page 2 of the examiner's answer (Paper No. 20).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Clarkson	1,449,145	Mar. 20, 1923
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Rogow	Des. 142,670	Oct. 23, 1945
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"The Personal Touch™", An Artistic Greeting Catalog, Fall, 1994, pg. 39, item A. A to Z Initial Pads. (PT)<sup>2</sup>

Claims 1, 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over PT.

Claims 2 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over PT in view of Clarkson.

Claims 1, 6 and 7 stand additionally rejected under 35 U.S.C. § 102(b) as being anticipated by Rogow.

Claims 2 and 5 stand additionally rejected under 35 U.S.C. § 103 as being unpatentable over Rogow in view of Clarkson.

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<sup>2</sup>While the date of this catalog is clearly subsequent to appellant's effective filing date, we note that appellant has not argued that PT is not available as a prior art reference in this case. Accordingly, we assume that the pads depicted in PT and relied upon by the examiner are prior art to appellant and we proceed with our decision in this appeal on that basis.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above rejections, we make reference to the examiner's answer and various supplemental answers (Paper Nos. 20, 22, 24 and 28) for the examiner's reasoning in support of the rejections, and to appellant's brief and various reply briefs (Paper Nos. 19, 21 and 27) for appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first to the examiner's rejection of claims 1, 6 and 7 under § 103 based on PT, we note that item No. 1490 on page 39 of PT is described as "A to Z Initial Pads" and that such pads are shown generally as being in the shape of a desired initial, such as the shown "N" and "S" pads, with "X" being the only letter of the alphabet indicated as "not available." From this disclosure, the examiner concludes that an "L" initial pad from

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PT would have a configuration generally like that set forth in appellant's claim 1 on appeal and that such a pad would be capable of use in the manner described in claim 1. To address the "central hinge" limitations of dependent claims 6 and 7 on appeal, the examiner indicates (answer, page 3) that

Steno pads are well known in the art. PT does not use a steno pad type hinge. It would have been obvious to modify PT by providing a steno type hinge since such is well known in the art for securing and versatility purposes.

Appellant's arguments regarding claim 1 urge that PT does not teach a reversible pad or a pad formed from two rectangular surfaces. More specifically, appellant indicates that there is no disclosure as to what the fancy letter "L" pad of PT looks like or if it even exists. As for claims 6 and 7, appellant argues that the examiner has used the claimed invention as a teaching guide to reconstruct the pads of PT. We do not find appellant's arguments persuasive with regard to claim 1 on appeal, but we agree with appellant as to claims 6 and 7.

Like the examiner, we are of the opinion that an "L" shaped pad as disclosed in PT would be fully responsive to the reversible writing pad set forth in claim 1 on appeal and would be usable in the manner required in appellant's claim 1. Since

PT indicates that only the letter "X" is not available, we find it reasonable to conclude that a pad in the shape of the letter "L" is available, and thus, contrary to appellant's position, that it does exist. While the exact configuration of the "L" shaped pad in PT may not be specifically known, we consider that it can be safely said that one of ordinary skill in this art would reasonably conclude that such a pad would comprise a plurality of vertically stacked sheets of paper with a writing surface on both sides of said sheets and that each of the sheets of such a pad would have a "substantially" rectangular larger vertically oriented leg or main message area/writing surface defining the longer leg of the "L" and a somewhat smaller "substantially" rectangular extension from the lower end of the longer leg defining the lower base leg of the "L," which is the configuration of the pad as broadly set forth in claim 1 on appeal. Given the substantial similarity in the configuration of the claimed "L" shaped pad and the "L" shaped pad of PT, we find it eminently reasonable to conclude that the "L" shaped pad of PT is also usable in the manner set forth in claim 1 on appeal.

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Accordingly, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103 based on PT.

As for the examiner's position regarding claims 6 and 7, we share appellant's view that the examiner's attempt to provide the "L" shaped pad of PT with a "central hinge" as required in claims 6 and 7 on appeal is based on an improper hindsight reconstruction motivated by having first viewed appellant's disclosed and claimed invention. For that reason, we will not sustain the examiner's rejection of claims 6 and 7 under 35 U.S.C. § 103 based on PT.

We next review the examiner's rejection of claims 1, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Rogow. Contrary to appellant's arguments, we consider that the article depicted in Rogow is generally "L" shaped, and that it includes a "substantially" rectangular vertically oriented leg or main writing surface/message area defining an upstanding leg of the "L" and a "substantially" rectangular extension from the lower end of the upstanding leg defining the lower base leg of the "L." While the extension seen in Rogow has a rounded top right corner, we nonetheless consider that the writing surface of the extension is "substantially" rectangular. As to the proper definition of

the term "book," we share the examiner's view as expressed on pages 5 and 6 of the supplemental answer mailed May 16, 1997 (Paper No. 28), and further point out that Rogow specifically indicates that the design therein is to "a bookor article of similar nature" (emphasis added). Moreover, since the configuration of the article in Rogow is substantially the same as that of the pad broadly set forth in claim 1 on appeal, we must conclude that it is clearly usable in the manner recited in claim 1.

As for dependent claim 6, we share the examiner's view that the front and back covers of the article in Rogow define "top and bottom surfaces" of the pad, and that when the article is opened to an intermediate page therein, the hinge seen at the left side of the article in Figure 1 of Rogow becomes a "central hinge" which extends vertically upwards (in the thickness dimension of the hinge and out of the paper) from the top (front) and bottom (back) surfaces and "through said writing surface." With regard to dependent claim 7, we observe that the "central hinge" as described above also extends "parallel" to the top (front) and bottom (back) surfaces, in the sense that it extends lengthwise



in the same plane as the front and back covers of the article when the article is opened in the manner noted above.

Based on the foregoing, we will sustain the examiner's rejection of claims 1, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Rogow.

The last of the examiner's rejections for our review are those of claims 2 and 5 under 35 U.S.C. § 103 as being unpatentable over PT in view of Clarkson and unpatentable over Rogow in view of Clarkson. The examiner points to the line of perforations (5) used in Clarkson to assist in separation of the receipt (3) from the remainder of a page of the ledger book therein and concludes that it would have been obvious to one of ordinary skill in the art to modify the "L" shaped writing pad of PT or the article of Rogow by providing a frangible line where desired as shown in Clarkson. Like appellant, we see nothing in the collective teachings of the applied prior art which would have led one of ordinary skill in the art to the combinations as proposed by the examiner. It is again our conclusion that the examiner has engaged in an improper hindsight reconstruction of

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the claimed invention from the writing pad of PT and the article in Rogow motivated by having first viewed appellant's disclosed and claimed invention. We do not believe that one of ordinary skill in the art would have used the teachings of the frangible line in the specialized receipt/ledger book of Clarkson to modify the simple writing pad of PT or the article in Rogow. Thus, the examiner's rejections of claims 2 and 5 under 35 U.S.C. § 103 will not be sustained.

Under the provisions of 37 CFR 1.196(b)(effective Dec. 1, 1997), the Board of Patent Appeals and Interferences is empowered to reject "any pending claim" in an application if they should have knowledge of grounds of rejection not involved in the appeal. We enter the following new ground of rejection against claims 3, 6 and 7 of the present application.

Claims 3, 6 and 7 are rejected under 35 U.S.C. § 112, first paragraph, as being directed to subject matter which finds no clear "written description" support in the specification as originally filed. Looking to the disclosure of the application as originally filed, we note that independent claim 1 in its present form on

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appeal and dependent claims 2 and 5 are specifically directed to the embodiment seen in Figures 1 through 3 of the application drawings, with dependent claim 3 apparently being directed specifically to the embodiment of Figure 4, while dependent claims 6 and 7, respectively, are directed only to the memo calendars seen in Figures 5 and 6 of the drawings. As is apparent from a review of the application drawings and appellant's specification as originally filed, the embodiments seen in Figures 1-3, 4, 5 and 6 are each distinctly different from one another and there appears to be no way that claims drawn to one of the embodiments of Figures 4, 5 or 6 can be dependent from claims drawn to the other embodiment seen in Figures 1-3. In this regard, we view the respective embodiments of appellant's invention as originally filed as being mutually exclusive of one another. Accordingly, the subject matter now defined in dependent claims 3, 6 and 7 on appeal finds no support in the application as filed. Appellant has simply provided no indication in the disclosure of this application that the combination now recited in claim 1/3, 1/6, or 1/7 forms any part of his invention.

To summarize, we note that the examiner's rejection of claims 1, 6 and 7 under 35 U.S.C. § 103 as being unpatentable over PT, is

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affirmed as to claim 1, but reversed as to claims 6 and 7. The rejection of claims 2 and 5 under 35 U.S.C. § 103 as being unpatentable over PT in view of Clarkson is reversed. The examiner's rejection of claims 1, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Rogow is affirmed, while the rejection of claims 2 and 5 under 35 U.S.C. § 103 as being unpatentable over Rogow in view of Clarkson is reversed. It follows from the foregoing that the decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application abandonment or a second appeal, this case should be returned to the

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Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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Frank D. Gilliam  
4565 Ruffner Street  
Suite 200  
San Diego, CA 92111